UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address : COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
07/810,560	12/20/91	RUEGER D	CRP-001CP3FW

D.6.

EXAMINER
NUTTER, N

EDMUND R. PITCHER
TESTA, HURWITZ & THIBEAULT
EXCHANGE PLACE
53 STATE STREET
BOSTON, MA 02109

ART UNIT	PAPER NUMBER
1503	20

DATE MAILED: 02/26/92

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 20 Dec 1991 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), ____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, Form PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____.

Part II SUMMARY OF ACTION

1. ☒ Claims 1, 2 and 4 are pending in the application.

   Of the above, claims _____ are withdrawn from consideration.

2. ☒ Claims 3 and 5-27 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1, 2 and 4 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application apppears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☒ Other The drawings filed 23 January 1990 have been approved by the draughtsman.

EXAMINER'S ACTION

PTOL-326 (Rev.9-89)

Claims 1, 2 and 4 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 2 and 4 recite only the sequence of one of the dimeric pains, and is not indicative of the other protein component.

The term "sufficiently duplicative" in claim 21 is vague since "sufficiently" is qualitative rather than quantitative.

35 U.S.C. § 101 reads as follows:

> "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

Claims 1, 2 and 4 are rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 21-45 and 51 of prior U.S. Patent No. 5,011,691. This is a double patenting rejection.

Claims 1, 2 and 4 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 21-45 and 51 of U.S. Patent No. 5,011,691. Although the conflicting claims are not identical, they are not patentably distinct from each other because the mode

of production, i.e., recombinant technology, solid phase synthesis, etc. is irrelevant since the proteins are essentially identical or would appear to be so.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

Claims 1, 2 and 4 are rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 32-53 and 62 of prior U.S. Patent No. 5,002,770. This is a double patenting rejection.

Claims 1, 2 and 4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 32-53 and 62 of copending application Serial No. 5,002,770. Although the conflicting claims are not identical, they are not patentably distinct from each other because no differences have been shown on the record as to the proteins of the instant claims and those recited in the claims of the patent.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

This is a continuation of applicant's earlier application S.N. 660,162. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds or art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See M.P.E.P. § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Nathan M. Nutter

NATHAN M. NUTTER
PATENT EXAMINER
ART UNIT 153

N. Nutter:amw
February 25, 1992
703-308-2351

February 19, 1992